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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,097	07/10/2001	Satoru Miyashita	101050.02	8398

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EXAMINER

TARAZANO, DONALD LAWRENCE

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,097

Applicant(s)

MIYASHITA ET AL.

Examiner

D. Lawrence Tarazano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-46 and 54-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36-46 and 54-77 is/are allowed.
- 6) ☒ Claim(s) 25, 26, 29, 35, 78 and 79 is/are rejected.
- 7) ☒ Claim(s) 27, 28 and 30-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/101,083.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) sept 30.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 25, 26, 29, 35, and 79 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicants' disclosure is only enabling for electro luminescent devices; the applicants' claims are much broader than the original disclosure. While the applicants have shown that their materials are semiconductors, there are semiconductor materials, which are not suitable for the production of electro luminescent devices, and these materials would be outside the scope of the original disclosure. The amended claims encompass materials that the applicants had never conceived of being used in their invention. Semiconductor materials are used in other applications such as transistors, capacitors, etc all of which are outside the scope of the original disclosure. The applicants did not "possess" the invention claimed and fail to meet the requirements of "written description"

3. Claims 25, 26, 29, 35, and 79 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. An electro luminescent layer is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Claims 25, 26, 29, and 35 are

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directed generically to semiconductor materials. The applicants' original disclosure was directed to electro luminescent devices. There is no provision in the applicants' disclosure to produce any other devices. It is essential/critical that the applicants produce an EL device.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 25, 26, 29, 35, 78, and 79 are rejected under 35 U.S.C. 102(b) as being anticipated by Musho et al. (5,250,439) / (5,202,261).

6. Musho et al. teach that organic polymers such as polyalkylthiophenes (column 22, lines 49+) are made conducting by doping them with an appropriate oxidizer. These materials can be easily dissolved and processed by ink-jet methods. Suitable solvents include chloroform (column 31, lines 65+). A polymer layer is formed on a substrate by applying a solution (a mixture of organic solvent with polymer) and then drying it (column 32, lines 15+).

7. The applicant's claims are directed to "semiconductor" materials applied by ink-jet printing in which claim 78 lists polyalkylthiophenes as being a "semiconductor" material.

8. While Musho et al. call their "polyalkylthiophenes" conducting polymers; these materials only become conducting once they have been doped. Therefore, they are semi-conducting materials upon application and formation of the layer.

9. Claim 25 states:

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A process for forming a pattern on a substrate by deposition of an organic material comprising the steps of:

Depositing a semiconducting organic material in a solve onto a substrate by ink-jet printing; and

Evaporating the solvent, whereby said organic material remains on the substrate.

First the prior art uses the same method as claimed “ink-jet printing” using a “semiconducting organic material” which is dissolved in an organic solvent. Therefore, all the limitations in the body of the claim are met. Regarding the limitation in the preamble that the method is “a process for forming a pattern on a substrate”. The body of the claim does not require that a pattern be formed, only that the process could be used for this purpose. Since the prior art uses an ink-jet printing method a pattern could be formed.

Furthermore, even if the preamble was considered to “breath life and meaning” to the claimed process, the examiner notes that no particular pattern is required. The examiner takes the position that what is produced in Musho et al. is a “solid pattern” based on the way it was formed.

Finally, “Print” as defined by Webster’s New Word Dictionary is (3) Lettering or other impression made in ink from type by a printing press or other means.... (4) A design or picture transferred from a medium,.... “Printing” is the process...of producing printed material.... Thus the term “ink-jet printing inherently means that a design or “pattern” is formed, even if this is on a microscopic scale based on the way the ink is laid down.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 25, 26, 29, 35 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musho et al. (5,250,439).

12. Musho et al., as discussed above, teach that materials such as polyalkylthiophenes (column 22, lines 49+) are made conducting by doping the materials with an appropriate oxidizer. These materials can be processed by ink-jet methods along with a limited number of other methods.

13. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have applied the dissolved semiconducting polyalkylthiophenes taught by Musho et al. by ink jet methods, since this would be a convenient way of making a (solid) patterned layer.

Allowable Subject Matter

14. Claim 27,28 and 30-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 36-46 and 54-77 are allowed.

Response to Arguments

The applicants' request for interference proceedings with Sturm et al. (paper12) is held in abeyance at this time to allow the outstanding issues to be resolved.

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Claim Rejections - 35 USC § 112

The applicants continue to argue that they have support for the claimed invention. The examiner maintains that no support exists. The examiner reviewed the applicants' arguments and maintains his position. This is simply a case where the applicants wish to capture embodiments outside the scope of the original disclosure in order to enter in to interference. At this point the case has been rejected at least twice. The examiner believes that the we have reached an impasse and have agreed to disagree.

The applicants have provided additional arguments and stated that examiner has not properly treated claim 79. While there are instances where the courts have determined that the applicants have meet the requirements of "written description" those fact patterns are very different from those of the instant application. The examiner feels that the limitations of claim 78 were not new and the elements of the claim are met by / obvious over the reference as stated above. The status of claims 27,28 and 30-34 was clarified; the applicants are correct; these claims are objected depending from rejected claims.

The applicants originally filled an application directed to a method of forming EL devices by an ink jet printing method. Another applicant filed claims directed to a method of ink jet printing an organic semiconductor and received a patent on that subject matter. The applicants now feel that they should also be entitled to all organic semiconductors because they have examples of materials which are organic semiconductors. The examiner maintains that the applicants have expanded the scope of the claims beyond the original disclosure. It is unclear to the examiner how the scope of the claims can be reasonably be expanded to encompass "organic semiconductors" in general even after reading all of the applicants' arguments.

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MPEP: 2162: To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116. >However, a showing of possession alone does not cure the lack of a written description. *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 296 F.3d 1316, 1330, 63 USPQ2d 1609, 1617 (Fed. Cir. 2002).

The "written description" question similarly arises in the interference context, where the issue is whether the specification of one party to the interference can support the newly added claims corresponding to the count at issue, i.e., whether that party can "make the claim" corresponding to the interference count.

See, e.g., *Martin v. Mayer*, 823 F.2d 500, 503, 3 USPQ2d 1333, 1335 (Fed. Cir. 1987).

In considering whether Mayer has the right to make the claim corresponding to the count for interference purposes, the only inquiry is whether Mayer's disclosure contains, in accordance with the principles of section 112 paragraph 1, support for all material limitations of the claim as presented in Martin's patent. *Squires v. Corbett*, 560 F.2d 424, 433, 194 USPQ 513, 519 (CCPA 1977). Martin's disclosure cannot be drawn upon to fill any gaps in that of Mayer.

Section 112 does not require that the specification contain that which is known to those skilled in the art. *Machinenfabrik GMBH v. American Moist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). But it does require specificity as to the claim limitations that characterize the interference count. It is "not a question of whether one skilled in the art *might* be able to construct the patentee's device from the teachings of the disclosure Rather, it is a question whether the application necessarily discloses that particular device."

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Jepson v. Coleman , 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963) (emphasis in original).

The specification must "convey clearly to those skilled in the art to whom it is addressed . . . the information that [he] has invented the specific subject matter **later** claimed." (emphasis added) *In re Ruschig* , 379 F.2d 990, 995-96, 154 USPQ 118, 123 (CCPA 1967).

In this instance it is the examiner's position that the applicants fail to have support for the broad coverage of "ink jet printing organic semiconductors". This concept is well outside of the scope of the original specification.

The grant of a patent is part of a quid-pro-quo system in which the inventor receives exclusive rights to his invention for a limited time in exchange for describing how to make and use the claimed invention. The written description requirement is designed to ensure that the inventor had actual possession of what is being claimed at the time the invention was made and that the specification teaches how to make and use the invention claimed.

During the review of a patent application, the scope of the claims is compared to the patent disclosure (claims, specification, drawings, and abstract as originally filed) to determine if the applicant had possession of the invention claimed.

To satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed.

Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was

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complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention.

In this instance the applicants are attempting to expand the scope of the claims to include embodiments for which they did possess and are not adequately described in the specification as originally filed. The applicants lack support for the breadth of the claims. The applicant fails to meet the requirements of written description, as they did not possess the claimed invention.

The following additional information related to written description is available from the USPTO:

The Interim Written Description Guidelines:

<http://www.uspto.gov/web/menu/written.pdf>

Manual of Patent Examination Procedure: 2163.03, Compliance with the Written Description Requirement

http://www.uspto.gov/web/offices/pac/mpep/documents/2100_2163_02.htm#sect2163.02

Claim Rejections - 35 USC § 102/103

Regarding the art rejection, The examiner maintains that one: The applicants claim “a method for forming a pattern”. First, a pattern is not claimed, Second, there only has to be the capability of forming a pattern. Thus, the prior art meets the structural limitations of the claim, and meets the intended use, since the method can function in that capacity.

Even if the term pattern is given more weight, the applicants do not claim any particular pattern. In jet printing is commonly used in computer printers. In those applications where solid areas are to be printed, the ink jet dots are put very close together make what appears to be a solid coating, but on a microscopic scale there still are dots. The prior art uses in jet printing, a

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process to form a solid coating, but the examiner maintains that it would have a dot pattern on a microscopic scale. The applicants argue that the prior art teaches a solid coating, but in the same context, the prior art uses "ink-jet printing". The term "printing" means that some form of pattern is formed. The term print refers to lettering or other impression made in ink from type by a printing press or other means. Thus, ink-jet printing must form an "impression", "lettering" or some form of "pattern" inherently.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (571)-272-1515. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Lawrence Tarazano
Primary Examiner
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A handwritten signature in black ink, appearing to be 'DLT' or similar, enclosed within a circular or oval shape.